UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,350	08/22/2003	John Overton	11958-60	8364

7590   05/28/2008

Joseph F. Hetz
BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

EXAMINER
PULLIAM, CHRISTYANN R

ART UNIT	PAPER NUMBER
2165	

MAIL DATE	DELIVERY MODE
05/28/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/646,350	OVERTON ET AL.
	Examiner	**Art Unit**	
	Christyann Pulliam	2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>28 February 2008 and 21 November 2007</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1,3-6 and 13-21</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1,3-6 and 13-21</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>21 November 2007</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   Claims 1, 3-6 and 13-21 are pending as amended November 21, 2007 and

February 28, 2008 (response to non-compliant amendment).

2.   The amendments have overcome objections to the drawings, specification and

claims as well as the 112 (2nd) rejection presented in the prior office action.

3.   New grounds of rejection are provided as necessitated by the amendments. This

action is FINAL.

Specification

4.   The specification is objected to as failing to provide proper antecedent basis for

the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The claims

use the term "computer-readable medium" in new Claims 20 and 21. This term is

undefined in the specification. For the purposes on examination, the term "computer-

readable medium" is interpreted to include only statutory media and <u>not</u> include signals,

waves or transmission media. The specification cannot be amended to define the term

without adding new matter. In response to this office action, the proper reply would be

to make a statement on the record that limits "computer-readable medium" to statutory

media only.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5.   Claims 1, 13 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not describe the movement of data or the association of a unique location identifier of a different data generating device. The specification does appear to discuss adding the unique identifier to additional servers, but no data appears to be moved from one place to another. It is unclear how the association of a different location identifier would occur since this is not expressly and specifically presented in the specification. Therefore, Claims 1, 13 and 20 do not comply with the written description requirement.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7.   Claims 1, 3-6, 13-17 and 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by <u>Experton</u>, U.S. Patent No. 5,995,965 (hereinafter <u>Experton</u>)-previously cited.

As for Claim 1, <u>Experton</u> teaches:

A method for indexing data in a network based on unique identifiers, comprising the steps of:

establishing a unique location identifier for each of a plurality of data generating devices on a network, the unique location identifier for identifying the location of each of the plurality of data generating devices in the network (See e.g. <u>Experton</u> – remote processing unit data – col. 8, lines 29-46 and col. 9, lines 15-20 – remote network address of the needed remote processing facility and col. 9, lines 49-52 - remotei);

registering the unique location identifier of each of the plurality of data generating devices on at least one server connected to the network when the data generating device is first used on the network (See e.g. <u>Experton</u> – central list of user information sites – col. 6, lines 11-20);

establishing a unique identifier for data generated by the data generating devices (See e.g. <u>Experton</u> –sub-addresses - col. 8, lines 29-46 and col. 9, line 53-col. 10, line 10);

registering the unique identifier for data generated by the plurality of data generating devices on the at least one server, wherein registering the unique identifier

further comprises associating the unique identifier with a first unique location identifier
(See e.g. Experton – central list of user information sites – col. 6, lines 11-20 and col. 6,
lines 38-450); and

associating, at the at least one server, the unique identifier associated with the
first unique location identifier with a unique location identifier of a different data
generating device in response to movement of data identified by the unique identifier to
the different data generating device (See e.g. Experton – col. 6, lines 12-20 and col. 8,
lines 59-66).

As for Claim 3, Experton teaches parent Claim 1. Experton also teaches further
comprising the step of storing the unique identifier on a token (See e.g. Experton col. 4,
lines 38-50 and col. 5, lines 15-33).

As for Claim 4, Experton teaches parent Claims 1 and 3. Experton also teaches
further comprising the step of the user using the token for subsequent uses of any of the
plurality of data generating devices (See e.g. Experton col. 4, lines 38-50 and col. 5,
lines 15-33 and col. 10, lines 3-20).

As for Claim 5, Experton teaches parent Claim 1. Experton also teaches further
comprising the step of retrieving data generated by one of the plurality of data
generating devices by manipulating the unique identifier associated with that data

wherein the data generated is medical data concerning the user (See e.g. col. 9, line 10

– col. 10, line 20).

As for Claim 6, Experton teaches parent Claim 1 and 5. Experton also teaches

wherein the unique identifier is transmitted to the at least one server data (See e.g.

Experton – col. 9, line 28- col. 10, line 20).

As for Claim 13, Experton teaches:

A method for storing establishing and retrieving data based on unique identifiers

global indices and unique location identifiers maintained in at least one server in a

network having a plurality of data generating devices comprising the steps of:

establishing a unique location identifier for a respective one of the plurality of

data generating devices on the network at the respective one of the plurality of data

generating devices (See e.g. Experton – remote processing unit data – col. 8, lines 29-

46 and col. 9, lines 15-20 – remote network address of the needed remote processing

facility and col. 9, lines 49-52 - remotei);

registering the unique location identifier of each of the plurality of data generating

devices on the network on the at least one server when the respective one of the data

generating devices is first used on the network (See e.g. Experton – central list of user

information sites – col. 6, lines 11-20);

generating a unique data identifier at the respective one of the plurality of data

generating devices for data generated at the respective one of the plurality of data

generating devices when the data is created (See e.g. Experton –sub-addresses - col. 8, lines 29-46 and col. 9, line 53-col. 10, line 10);

storing on the at least one server an association of unique data identifiers for data generated by each of the plurality of data generating devices, and unique location identifiers of each of the plurality of data generating devices that generated the data identified by the unique identifier (See e.g. Experton – central list of user information sites – col. 6, lines 11-20 and col. 6, lines 38-45 and col. 8, lines 59-66); and

the at least one server initiating a manipulation of an association of unique identifier and unique location identifier to change a unique identifier association from a unique location identifier of a first data generating device to a unique location identifier of a second data generating device, and instructing the first and second data generating devices regarding the change of unique identifier association (See e.g. Experton – col. 6, lines 12-20 and col. 8, lines 59-66).

As for Claim 14, Experton teaches parent Claim 13. Experton also teaches wherein the plurality of data generating devices comprise client entities (See e.g. Experton – col. 2, line 17-col. 3, line 5, col. 4, lines 40-50 and col. 5, lines 15-25).

As for Claim 15, Experton teaches parent Claims 1, 5-6. Experton also wherein the at least one server responds by providing the unique location identifier for the unique identifier. (See e.g. Col. 9, lines 10-55 and col. 10, lines 5-20).

As for Claim 16, <u>Experton</u> teaches parent Claim 1, 5-6 and 15. <u>Experton</u> also

teaches wherein the at least one server stores the association of the unique identifier to

at least one unique location identifier (See e.g. <u>Experton</u> - col.6, line 10-20).

As for Claim 17, <u>Experton</u> teaches parent Claim 13. <u>Experton</u> also teaches

further comprising the step of adding new data to the network by creating a new

association of another unique data identifier to a unique location identifier of an

appropriate one of the plurality of data generating devices (See e.g. <u>Experton</u> – col. 8,

lines 30-51, col. 5, line 56-col 6, line 20 and col. 6, lines 39-50).

As for Claim 19, <u>Experton</u> teaches parent Claim 13. <u>Experton</u> also teaches

further comprising the step of updating data in the network by modifying an association

of a unique data identifier to a unique location identifier (See e.g. <u>Experton</u> – col. 6, lines

1-20 and col. 9, lines 39-48 and col. 10, lines 3-20 and col. 11, lines 15-35).

As for Claim 20, <u>Experton</u> teaches:

A computer readable medium containing computer executable code

for indexing data in a network based on unique identifiers, the computer executable

code comprising instructions for:

receiving a unique location identifier from each of a plurality of data generating

devices on the network, wherein each unique location identifier identifies a location of a

respective one of the plurality of data generating devices in the network (See e.g.

Experton – remote processing unit data – col. 8, lines 29-46 and col. 9, lines 15-20 –

remote network address of the needed remote processing facility and col. 9, lines 49-52

- remotei);

registering the unique location identifier of one of the plurality of data

generating devices in communication with the network when the one of the plurality of

data generating devices is first used on the network(See e.g. Experton – central list of

user information sites – col. 6, lines 11-20);

receiving a unique identifier generated by one of the plurality of data

generating devices when the one of the plurality of data generating devices generates

data (See e.g. Experton –sub-addresses - col. 8, lines 29-46 and col. 9, line 53-col. 10,

line 10);

registering the unique identifier for the data generated by the one of the

plurality of data generating devices, wherein registering the unique identifier further

comprises associating the unique identifier with a unique location identifier of the one of

the plurality of data generating devices (See e.g. Experton – central list of user

information sites – col. 6, lines 11-20 and col. 6, lines 38-450); and

associating the unique identifier associated with the unique location identifier with

a unique location identifier of a different data generating device in response to

movement of data identified by the unique identifier to the different data generating

device (See e.g. Experton – col. 6, lines 12-20 and col. 8, lines 59-66).

As for Claim 21, <u>Experton</u> teaches parent Claim 20. <u>Experton</u> also teaches

further comprising instructions for automatically detecting and integrating spontaneously

added data generating devices at the at least one server (See e.g. <u>Experton</u> –

continuous and automatic updates - col. 11, lines 51-65 and col. 11, lines 15-35).

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

9.   Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over

<u>Experton</u> as applied to claim 18 above, in view of <u>Hamala et al.</u>, U.S. Patent No.

5,345,586 (hereinafter <u>Hamala</u>).

As for Claim 18, <u>Experton</u> teaches parent Claim13. <u>Experton</u> teaches updates to

data but does not expressly address removing data from the network. However,

<u>Hamala</u> teaches further comprising the step of removing data from the network by

deleting an association of a unique data identifier to a unique location identifier (See

e.g. <u>Hamala</u> – col. 4, lines 2-23 – delete rules, col. 4, line 62-col. 5, line 8 – mapping

and col. 5, line 37- col. 6, line 10 – deleting).

<u>Experton</u> and <u>Hamala</u> are from the analogous art of networked data access. It

would have been obvious to one of ordinary skill in the art at the time the invention was

made having the teachings of <u>Experton</u> and <u>Hamala</u> to have combined <u>Experton</u> and

<u>Hamala</u>. The motivation to combine <u>Experton</u> and <u>Hamala</u> is explain deleting of data

not just updating. Both <u>Experton</u> and <u>Hamala</u> are providing access to data that is stored

across a network without regard for the type or form of the data. <u>Experton</u> and <u>Hamala</u>

both also provide for levels of security in access different data across the network.

Hamala explains that data can be deleted and that deleting includes removing

relationship and mapping that are associated with that data. Therefore, it would have

been obvious to one of ordinary skill in the art to have combined <u>Experton</u> and <u>Hamala</u>.

Response to Arguments

10.   Applicant's arguments have been fully considered but they are not persuasive.

The amendments to the claims necessitated the new grounds of rejection based mainly

on <u>Experton</u>.

        <u>Experton</u> teaches the amended claims because <u>Experton</u> teaches identifiers for

devices (network address of facility) and for data (user plus sub-address). These

identifiers are associated with each other. They are also put on a server in addition to

the main example smart card. The data can be updated from various devices across

the network. The identifiers maybe different that the ones intended by the current

invention, but the claims only require unique identifiers and unique location identifiers.

<u>Experton</u> has both. Therefore, <u>Experton</u> teaches the requirements of the broad claims.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,276,735 teaches media with keys for devices and data that can be networked to a server and workstations.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christyann Pulliam whose telephone number is (571)270-1007. The examiner can normally be reached on M-F 9 am-6 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Christian Chace can be reached on 571-272-4190. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. P./
Examiner, Art Unit 2165
May 23, 2008

/Neveen Abel-Jalil/
Primary Examiner, Art Unit 2165